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10/809,586	03/25/2004	Joseph Won John	AUS920040008US1	7114
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INTERNATIONAL CORP (BLF)			SHIU, HO T	
c/o BIGGERS & OHANIAN, LLP				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/809,586	<b>Applicant(s)</b> JOHN, JOSEPH WON	
	<b>Examiner</b> HO SHIU	<b>Art Unit</b> 4152	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 March 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>25 March 2004</u> .   | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. Claims 1-24 are pending in this application.

### ***Claim objections***

2. Claims 17-24 are rejected under 35 U.S.C. 112 2<sup>nd</sup> paragraph for lack of antecedent basis. Claims 17-24 recites "the recording medium". There is insufficient antecedent basis for this limitation in the claims

### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 9-24 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

With respect to claim 9, "A system for establishing trust in an email client" is being recited. A system for establishing trust in an email client comprises of components that are software. A software is not one of the statutory subject matter.

See MPEP § 2106.01

5. With respect to claims 10-16, they are dependent claims of claim 9. Therefore, they are rejected for the same reasons in claim 9 above as not one of the statutory subject matter. See MPEP § 2106.01

6. With respect to claims 17-24, "computer program product" is being recited. A computer program product is comprises components that are software. A software is not one of the statutory subject matter. See MPEP § 2106.01

***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**11. Claims 1, 2, 4-10, 12-18, 20-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Weatherby et al. (Pub # US 20004/0054741 A1, hereinafter Weatherby).**

12. With respect to claim 1, Weatherby discloses a method for establishing trust in an email client, the method comprising:

accepting in an email server a data communications connection from an email client ([0029], lines 2-3), wherein the connection includes the email client's network address ([0030], lines 1-4);

determining from a stored list of trusted network addresses whether the email client is trusted according to the email client's network address ([0033], lines 1-6);

if the email client is not trusted according to the email client's network address, receiving authentication data from the email client and determining whether the email client is trusted according to the authentication data ([0015], lines 1-9); and

if the email client is not trusted according to the email client's network address and the email client is not trusted according to the authentication data, receiving a sender domain name for an email message from the email client and determining whether the email client is trusted according to the sender domain name ([0030], lines 1-7).

13. With respect to claim 2, Weatherby discloses determining whether the email client is trusted according to the sender domain name further comprises requesting from a domain name service a resource record of a type that lists for a sender domain network addresses of email exchanges that are authorized to act as outbound email exchanges for the sender domain ([0030], lines 1-7, [0041], lines 1018).

14. With respect to claim 4, Weatherby discloses the email client is trusted according to the authentication data, and the method further comprises storing the email client's

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network address in association with a trust time limit in the list of trusted network addresses ([0040], lines 1-7).

15. With respect to claim 5, Weatherby discloses accepting in the email server a connection from an email client requesting delivery of an email message ([0029], lines 2-3) according to a protocol that includes client authentication ([0031], lines 1-3, wherein the connection includes the network address of the email client requesting delivery of an email message ([0029], lines 4-6, lines 10-13); authenticating the email client requesting delivery of an email message ([0030], lines 1-4, [0031], lines 1-3); delivering the email message to the email client requesting delivery of an email message ([0030], lines 7-11); and storing the network address of the email client requesting delivery of an email message in association with a trust time limit in the list of trusted network addresses ([0040], lines 1-7).

16. With respect to claim 6, Weatherby discloses the email client is an email exchange that accepts outbound email messages only from trusted senders ([0033], lines 1-6).

17. With respect to claim 7, Weatherby discloses receiving a sender domain name further comprises receiving the sender domain name in an SMTP MAILFROM message ([0029], lines 4-6).

18. With respect to claim 8, Weatherby discloses the email client is not trusted according to the email client's network address, the email client is not trusted according to the authentication, the email client is not trusted according to the sender domain name, and the method further comprises sending an error message to the email client and closing the connection ([0030], lines 7-9, [0031], lines 1-3, lines 7-8).

19. With respect to claim 9, Weatherby discloses a system for establishing trust in an email client, the system comprising:

means for accepting in an email server a data communications connection from an email client ([0029], lines 2-3), wherein the connection includes the email client's network address ([0030], lines 1-4);

means for determining from a stored list of trusted network addresses whether the email client is trusted according to the email client's network address ([0033], lines 1-6);

means for receiving authentication data from the email client and means for determining whether the email client is trusted according to the authentication data if the email client is not trusted according to the email client's network address ([0015], lines 1-9 ); and

means for receiving a sender domain name for an email message from the email client and means for determining whether the email client is trusted according to the sender

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domain name if the email client is not trusted according to the email client's network address and the email client is not trusted according to the authentication data ([0030], lines 1-7).

20. With respect to claim 10, Weatherby discloses means for determining whether the email client is trusted according to the sender domain name further comprises means for requesting from a domain name service a resource record of a type that lists for a sender domain network addresses of email exchanges that are authorized to act as outbound email exchanges for the sender domain ([0030], lines 1-7, [0041], lines 10-18).

21. With respect to claim 12, Weatherby discloses the email client is trusted according to the authentication data, and the system further comprises means for storing the email client's network address in association with a trust time limit in the list of trusted network addresses ([0040], lines 1-7).

22. With respect to claim 13, Weatherby discloses means for accepting in the email server a connection from an email client requesting delivery of an email message ([0029], lines 2-3) according to a protocol that includes client authentication ([0031], lines 1-3, wherein the connection includes the network address of the email client requesting delivery of an email message ([0029], lines 4-6, lines 10-13);



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means for authenticating the email client requesting delivery of an email message

([0030], lines 1-4, [0031], lines 1-3);

means for delivering the email message to the email client requesting delivery of an email message ([0030], lines 7-11); and

means for storing the network address of the email client requesting delivery of an email message in association with a trust time limit in the list of trusted network addresses ([0040], lines 1-7).

23. With respect to claim 14, Weatherby discloses the email client is an email exchange that accepts outbound email messages only from trusted senders ([0033], lines 1-6).

24. With respect to claim 15, Weatherby discloses means for receiving a sender domain name further comprises means for receiving the sender domain name in an SMTP MAILFROM message ([0029], lines 4-6).

25. With respect to claim 16, Weatherby discloses means for sending an error message to the email client and means for closing the connection if the email client is not trusted according to the email client's network address, the email client is not trusted according to the authentication, and the email client is not trusted according to the sender domain name ([0030], lines 7-9, [0031], lines 1-3, lines 7-8).

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26. With respect to claim 17, Weatherby discloses a computer program product for establishing trust in an email client, the computer program product comprising: means, recorded on the recording medium ([0059], lines 9-14), for accepting in an email server a data communications connection from an email client ([0029], lines 2-3), wherein the connection includes the email client's network address ([0030], lines 1-4); means, recorded on the recording medium ([0059], lines 9-14), for determining from a stored list of trusted network addresses whether the email client is trusted according to the email client's network address ([0033] lines 1-6); means, recorded on the recording medium ([0059], lines 9-14), for receiving authentication data from the email client and means, recorded on the recording medium, for determining whether the email client is trusted according to the authentication data if the email client is not trusted according to the email client's network address ([0015], lines 1-7); and means, recorded on the recording medium ([0059], lines 9-14), for receiving a sender domain name for an email message from the email client and means, recorded on the recording medium, for determining whether the email client is trusted according to the sender domain name if the email client is not trusted according to the email client's network address and the email client is not trusted according to the authentication data ([0030], lines 1-7).

27. With respect to claim 18, Weatherby discloses means, recorded on the recording medium, for determining whether the email client is trusted according to the sender

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domain name further comprises means, recorded on the recording medium, for requesting from a domain name service a resource record of a type that lists for a sender domain network addresses of email exchanges that are authorized to act as outbound email exchanges for the sender domain ([0030], lines 1-7, [0041], lines 10-18).

28. With respect to claim 20, Weatherby discloses the email client is trusted according to the authentication data, and the computer program product further comprises means, recorded on the recording medium, for storing the email client's network address in association with a trust time limit in the list of trusted network addresses ([0040], lines 1-7).

29. With respect to claim 21, Weatherby discloses means, recorded on the recording medium, for accepting in the email server a connection from an email client requesting delivery of an email message ([0029], lines 2-3) according to a protocol that includes client authentication ([0031], lines 1-3), wherein the connection includes the network address of the email client requesting delivery of an email message ([0029], lines 4-6, lines 10-13);

means, recorded on the recording medium, for authenticating the email client requesting delivery of an email message ([0030], lines 1-4, [0031], lines 1-3);

means, recorded on the recording medium, for delivering the email message to the email client requesting delivery of an email message ([0030], lines 7-11); and

means, recorded on the recording medium, for storing the network address of the email client requesting delivery of an email message in association with a trust time limit in the list of trusted network addresses ([0040], lines 1-7).

30. With respect to claim 22, Weatherby discloses the email client is an email exchange that accepts outbound email messages only from trusted senders ([0033], lines 1-6).

31. With respect to claim 23, Weatherby discloses means, recorded on the recording medium, for receiving a sender domain name further comprises means, recorded on the recording medium, for receiving the sender domain name in an SMTP MAILFROM message ([0029], lines 4-6).

32. With respect to claim 24, Weatherby discloses means, recorded on the recording medium, for sending an error message to the email client and means, recorded on the recording medium, for closing the connection if the email client is not trusted according to the email client's network address, the email client is not trusted according to the authentication, and the email client is not trusted according to the sender domain name ([003], lines 7-9, [0031], lines 1-3, lines 7-8).

***Claim Rejections - 35 USC § 103***

33. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**34. Claims 3, 11, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weatherby as applied to claims 1, 9, and 17 in view of Lalonde et al. (US Pub # 2004/0068542 A1, hereinafter Lalonde).**

35. With respect to claims 3, 11, and 19, Weatherby discloses the method step, means for, and computer program product recorded on the recording medium for determining whether the e-mail client is trusted according to the sender domain name further comprises determining whether a domain name service resource record associates the email client's network address with the sender domain name and lists for a sender domain network addresses of email exchanges that are authorized to act as outbound email exchanges for the sender domain ([0030], lines 1-7, [0041], lines 10-18) but does not disclose the DNS resource record being of a type that lists for a sender domain network addresses of email exchanges that are authorized to act as outbound email exchanges for the sender domain.

In the same field of endeavor, Lalonde discloses the DNS resource record being of a type that lists for a sender domain network addresses of email exchanges that are authorized to act as outbound email exchanges for the sender domain ([0039], lines 8-13).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of Weatherby with the teachings of Lalonde in order to extract the IP address from the server domain name and vice versa.

36. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HO SHIU whose telephone number is (571)270-3810. The examiner can normally be reached on Mon-Thur (7:30am - 6:00pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nabil El-Hady can be reached on 571-272-3963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Nabil El-Hady/

Supervisory Patent Examiner, Art Unit 4152